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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/616,718	07/14/2000	Bert L. Vallee	11187-00001	5959

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EXAMINER

DELACROIX MUIRHEI, CYBILLE

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 08/28/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/616,718

Applicant(s)

VALLEE ET AL.

Examiner

Cybille Delacroix-Muirheid

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2 and 13-15 is/are allowed.
- 6) ☒ Claim(s) 3, 5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Detailed Action

1. Claims 3, 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vallee et al., 5,204,369 or Vallee et al., 5,624,910.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

The following is responsive to the request for continued examination under 37 CFR 1.114 and the accompanying amendment received April 17, 2003.

No claims are cancelled. New claims 13-15 are added. Claims 1-3, 5-6 and 13-15 are currently pending.

The previous rejection of claims 3, 5 under 35 USC 103(a) over Keung et al., maintained in the office action mailed Nov. 20, 2002 **is withdrawn** in view of Applicant's amendment and the remarks contained therein.

The previous claim objection set forth in paragraph 3 of the office action mailed Nov. 20, 2002 **is withdrawn** in view of Applicant's amendment and the remarks contained therein.

The previous claim rejection under 35 USC 112, paragraph 2, set forth in paragraph 4 of the office action mailed Nov. 20, 2002 **is withdrawn** in view of Applicant's amendment and the remarks contained therein.

The previous double patenting rejection maintained in the office action mailed Nov. 20, 2002 **is withdrawn** in view of Applicant's amendment and the remarks contained therein.

However, Applicant's arguments traversing the previous rejection of claims 3, 5-6 under 35 USC 103(a) set forth in paragraphs 5-7 of the office action mailed Nov. 20, 2002 have been considered but are not found to be persuasive.

Said rejection is maintained essentially for the reasons given previously in the office action mailed Nov. 20, 2002 with the following additional comment:

It is essentially Applicant's position that Vallee '369 and '910 do not disclose or fairly suggest therapeutically reducing alcohol consumption by administering the claimed compound in an effective amount "to increase the concentration of an aldehyde formed during catabolism of a neurotransmitter." The '369 and '910 patents are primarily concerned with identifying ALDH-I inhibitory compounds and compositions. Therefore, these patents modify alcohol consumption via inhibition of ALDH-I.

Moreover, the patents are silent with respect to increasing the concentration of an aldehyde formed during catabolism of a neurotransmitter. On the other hand, Applicant has discovered a mechanistic basis for reducing alcohol consumption, that is to say that Applicant has discovered that the claimed compounds have the property of increasing the concentration of aldehydes formed during catabolism of a neurotransmitter.

Said arguments have been considered but are not found to be persuasive.

Concerning Applicant's argument that the patents do not disclose a method of reducing alcohol consumption by administering the claimed compound in an effective amount "to increase the concentration of an aldehyde formed during catabolism of a neurotransmitter", the Examiner respectfully submits that Applicant is arguing (as well as claiming) the effective amounts **functionally**, i.e. an effective amount to increase the concentration of an aldehyde formed during catabolism of a neurotransmitter. However, upon reference to the specification, the Examiner is unable to find any disclosure of effective amounts. Additionally, Applicant has not clearly argued how this amount desired by Applicant is not disclosed or is distinguished over the amount disclosed in the method of the prior art. Applicant has not specifically argued, on the record, how the claimed amounts of compound used in the claimed alcohol consumption reduction method differ from the amount of identical compound used in the alcohol consumption or alcohol abuse treatment methods in the prior art. Absent such arguments, the Examiner respectfully maintains that the claimed increase in aldehyde concentration would have been obvious in the method of the prior art.

Next, with respect to the discovery of the compound's ability to increase the concentration of aldehyde formed during catabolism of a neurotransmitter, the Examiner respectfully submits that the discovery of an unexpected property of a compound disclosed in the prior art does not necessarily render the claimed method unobvious since this property may be inherent in the prior art. Please see In re Best, 195 USPQ 430; In re Swinehart, 169 USPQ 226 ("a newly discovered property does not necessarily mean the product is unobvious, since this property may be inherent in the

prior art.”). Furthermore, the Examiner respectfully submits that Applicant’s argument addresses the discovery of an unexpected property of a compound already disclosed by the prior art. It does not serve to distinguish the claimed method from the method disclosed by Vallee ‘369 and ‘910.

It is for these reasons that the rejection is respectfully maintained.

Allowable Subject Matter

Claims 1, 2 and 13-15 are free from the prior art because the prior art does not disclose or fairly suggest Applicant’s claimed methods.

Conclusion

Claims 3, 5-6 are rejected.

Claims 1, 2, 13-15 are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is 703-306-3227. The examiner can normally be reached on Tue-Thur. from 8:30 to 6:00. The examiner can also be reached on alternate Mondays .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725 The fax phone number for the organization where this application or proceeding is assigned is 703-308-7924.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

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CDM 

August 24, 2003


Cybille Delacroix-Muirheid
Patent Examiner Group 1600